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IN THE

Supreme Court of the United States

OCTOBER TERM, 1961

No. 798

ALFRED DUNHILL OF LONDON, INC.,

Petitioner,

v.

DUNHILL TAILORED CLOTHES, INC.,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE COURT OF CUSTOMS AND PATENT APPEALS

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TABLE OF CONTENTS

	PAGE
Jurisdiction	2
The Questions Presented	2
The Statutes Involved	3
Statement	4
Reasons for Granting the Writ	7
Conclusion	11
Appendix A	13
Appendix B	36
Appendix C	38
Appendix D	48
Appendix E	52

TABLE OF CASES AND OTHER AUTHORITIES

Cases:

Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc., 293 F. 2d 685, 130 U.S.P.Q. 412 (C.C.P.A., 1961) 1

Alumatone Corporation v. Vita-Var Corporation, 183 F. 2d 612 (C.C.P.A., 1950) 10

In re Sebald, 148 F. 2d 366 (C.C.P.A., 1944) 8

In re Tucker, 54 F. 2d 815 (C.C.P.A., 1932) 8

PAGE

Mantz v. Jackson, 140 F. 2d 161 (C.C.P.A., 1944) 8

Meem-Haskins Coal Corporation v. Central Fuel Corporation, 137 F. 2d 242 (C.C.P.A., 1943) 10

Proctor & Gamble Co. v. J. L. Prescott Co., 77 F. 2d 98 (C.C.P.A., 1935) 10

Other Authorities:

Constitution of the United States, Article III (28 U.S.C. § 211; 72 Stat. 848) 2

28 U.S.C. § 1256 (62 Stat. 928) 2

Rule 19 of the Supreme Court Rules 2

35 U.S.C. § 144 ..... 3, 8

15 U.S.C. § 1052(d) 3, 7, 8, 10, 11, 12

15 U.S.C. § 1051 10

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TO THE HONORABLE, THE CHIEF JUSTICE OF THE UNITED STATES AND THE ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Your petitioner, Alfred Dunhill of London, Inc., respectfully prays for a writ of certiorari to the Court of Customs and Patent Appeals to review a final order of that Court entered on December 18, 1961.

The majority opinion of the Court of Customs and Patent Appeals and the opinions of two members of the Court disagreeing with the conclusion of the majority rendered August 16, 1961, are reported at 293 F. 2d 685 and 130 U.S.P.Q. 412 and are printed in Appendix A hereto.

A petition for rehearing was denied by the Court on December 18, 1961; and one of the Judges amplified his concurring opinion on the same date. The order of denial and the amplified opinion are printed in Appendix B hereto.

Jurisdiction

The Court of Customs and Patent Appeals is a court established under Article III of the Constitution of the United States (28 U.S.C. § 211; 72 Stat. 848), and the jurisdiction of this Court rests upon the specific language of 28 U.S.C. § 1256 (62 Stat. 928) as follows:

> "Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari."

Rule 19 of the Supreme Court Rules specifically applies the considerations governing review on certiorari to the Court of Customs and Patent Appeals and provides for review in cases such as this where the Court has decided an important question of federal law which has not been, but should be, decided by this Court, has interpreted a statute in such a way as to conflict with the language of the statute and its legislative history, and has so far departed from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

The Questions Presented

1. May the Court of Customs and Patent Appeals, on appeal from a decision of the Patent Office, decide a question which was not raised on appeal, in contravention of statutory limitations upon the authority of the Court, and, disregarding statutory requirements and established procedures, order the Patent Office to take action on a matter which was neither pending before, presented to, nor passed upon by the Patent Office?

2. May one who has been adjudged to be an intentional infringer and unfair competitor by reason of his adoption

and use of the trademark of another with the purpose, intent and result that the public has been confused and deceived, secure the benefits and advantages of federal registration of such mark, in contravention of the express prohibitions of the statute?

The Statutes Involved

35 U.S.C. § 144:

The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, *and the decision shall be confined to the points set forth in the reasons of appeal.* Upon its determination the Court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case. (Emphasis added.)

15 U.S.C. § 1052(d):

"No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(d) consists of or comprises a mark which so resembles a mark registered in the Patent Office or a mark or trade-name previously used in the United States by another and not abandoned, *as to be likely*, when applied to the goods of the applicant, *to cause confusion, mistake or to deceive purchasers. Provided*, That the Commissioner may register as concurrent registrations the same or similar marks to more than one registrant when they have become entitled to use such marks *as a result of their concurrent lawful use* thereof in commerce prior to any of the filing dates of the applications involved *and the Commissioner or a court on appeal determines that confusion or mistake*

or deceit of purchasers is not likely to result from the continued use of said marks under conditions and limitations as to the mode or place of use or the goods in connection with which such registrations may be granted which conditions and limitations shall be prescribed in the grant of the concurrent registrations thereof; and concurrent registrations may be *similarly* granted by the Commissioner with such conditions and limitations when a court has finally determined that more than one person is entitled to use the same or similar marks in commerce. The Commissioner shall give not less than thirty days' written notice to all applicants, registrants and users specified by any of the parties concerned of any application for concurrent registration and of the time and place of the hearings thereon. When the Commissioner decides to grant a concurrent registration, the proposed registration shall be published in the Official Gazette of the Patent Office and the application shall be subject to opposition as hereinafter provided in this Chapter for other applications to register marks. Concurrent registrations may be ordered by a court in an action under the provisions of 35 United States Code, Sections 145 or 146, under such conditions and limitations as the court considers proper in accordance herewith;" (Emphasis added.)

Statement

Petitioner is owner and user of the trademark "Dunhill" for tobacco products, smokers' articles, flat leather goods, razors, clocks and watches, toiletries, men's jewelry, canes and umbrellas, tea sets and caddies, bar fixtures and accessories, luggage, and other gift items. The trademark is registered to petitioner for the seven products first enumerated.

In 1957, respondent filed an application in the Patent Office to register "Dunhill" as a trademark for men's suits and overcoats, asserting that "the mark has become

distinctive of applicant's goods as a result of substantially exclusive and continuous use in interstate commerce for the five years next preceding the date of filing of this application."

Shortly thereafter, petitioner filed in the United States District Court for the Southern District of New York a civil action alleging that respondent's use of "Dunhill" in connection with its goods infringed petitioner's rights and constituted unfair competition with petitioner and had caused and was causing confusion and deception of purchasers. In such suit, petitioner sought to enjoin respondent from using the word "Dunhill" on or in connection with the sale of its goods. Also, respondent counterclaimed to enjoin petitioner from using the word "Dunhill" on or in connection with the sale of certain products. Upon the filing of this action, the Patent Office suspended respondent's application to register until termination of the suit.

After seven days of trial, the District Court entered findings of fact and conclusions of law and a final judgment, which are printed as Appendix C and D hereto. The Court found that petitioner is the owner of the trademark "Dunhill"; respondent's use of "Dunhill", whether alone or with other language, is an infringement of petitioner's trademark and trade name and constitutes unfair competition with petitioner; respondent is guilty of *intentional* infringement of petitioner's rights and *intentional* unfair competition with petitioner; a substantial number of the members of the public have been confused, mistaken or deceived by respondent's use of the word "Dunhill", whether alone or with other language, into the belief that respondent was petitioner or was a branch of or connected with petitioner, or that respondent's goods were plaintiff's goods. The Court dismissed respondent's counterclaim and enjoined respondent from using the word "Dunhill", either alone or in combination with other words or symbols, on or in connection with the sale of any products whatsoever. However, because of certain special cir-

cumstances, respondent was *permitted* by the Court to use the name "DUNHILL TAILORS" on certain products for men, including clothing, under specific limitations.

Respondent thereafter amended the mark which it sought to register by conforming it to the name permitted by the Court, but it did not amend the application either to seek concurrent registration or to eliminate reference to respondent's asserted "substantially exclusive use" of "Dunhill" as a trademark. When the amended mark was duly published, petitioner filed an opposition to the registration. Both parties moved for summary judgment, and the Trademark Trial and Appeal Board granted judgment to respondent and dismissed petitioner's opposition, holding that the District Court's decision "is conclusive, as between the parties, upon applicant's [respondent's] right to the use of the mark 'DUNHILL TAILORS' for such goods, and precludes a finding of damage to opposer [petitioner] from the registration sought by applicant [respondent]." The opinion and decision of the Board are printed in Appendix E hereto.

Petitioner appealed to the Court of Customs and Patent Appeals, and that Court, through three of its members, held, erroneously, it is submitted, that the District Court had found that respondent had substantive rights in "DUNHILL TAILORS", i. e., a *right* to continue to use the name, and that, therefore, it has the *right* to a concurrent registration restricted to the conditions and limitations set forth in the judgment of the District Court.

After noting that no application for concurrent registration had ever been filed or considered by the Patent Office and concurrent registration had not been mentioned in the reasons of appeal to the Court, a fourth member of the Court of Customs and Patent Appeals questioned the power of the Court to order the granting of a concurrent registration, especially where "Dunhill" had been found by the District Court and by the majority of the Court of

Customs and Patent Appeals to mean petitioner and its products. It was his opinion that the average purchaser would associate "Dunhill" and "DUNHILL TAILORS" to a degree which the provisions of Section 2(d) of the Statute [15 U.S.C. § 1052(d)] were intended to prevent.

The fifth member of the Court, after noting that the District Court had found that members of the public had in fact been confused, mistaken or deceived by respondent's use in its business of "Dunhill", whether alone or with other language, and after stating his own conviction that respondent's use of "DUNHILL TAILORS" is likely to result in purchaser confusion, held that registration is precluded by the specific language of Section 2(d) of the Statute [15 U.S.C. § 1052(d)]. With regard to the limited use of "DUNHILL TAILORS" permitted by the District Court, this member of the Court stated that equitable rights existing between two parties cannot justify the issuance of a registration in contravention of the express language of the statute.

A petition for rehearing was denied on December 18, 1961.

Reasons for Granting the Writ

The matters presented herein are of substantial public interest because they involve the relationship between the legislative and judicial branches of the Government. Specifically, they raise the following questions:

A. May a court disregard a statutory limitation placed upon its authority by Congress?; and

B. May a court disregard the statutory prohibition against registration of instruments of public deception, merely because of the existence of certain equitable rights between two parties?

There is no precise precedent for either of these questions, since there has been no interpretation of either of the statutes insofar as they are drawn into question here.

A. Under 35 U.S.C. § 144, the Court of Customs and Patent Appeals is bound by the Congressional enactment which specifically confines its decisions to the points set forth in the reasons of appeal. Under this enactment, a matter not raised on appeal may not be passed upon by the Court. Nevertheless, in this case, despite this restriction, the Court has passed upon a matter which was not included in the reasons of appeal and was not presented to the Court by either party, either in oral argument or otherwise.

Moreover, the Court has passed upon the matter of concurrent registration without its ever having been considered by the Patent Office. 15 U.S.C. § 1052(d) sets forth the statutory requirements for concurrent registration, as well as certain statutory procedures. In the present case, no application for concurrent registration was ever filed, the procedures set forth in the statute have not been followed, and there has been no finding by the Patent Office or by any court that confusion or deception of purchasers is not likely to result from respondent's continued use of "DUNHILL TAILORS".

The Court of Customs and Patent Appeals has, until now, properly confined its decisions to the points set forth in the reasons for appeal. In *re Sebald*, 143 F. 2d 366 (1944); *Mantz* v. *Jackson*, 140 F. 2d 161 (1944); In *re Tucker*, 54 F. 2d 815 (1932). Indeed, in the case first cited, the Court, after noting that "our powers of revision are strictly limited by statute to the points set forth in the reasons of appeal", commented that the narrowness of the scope of review or "revising power" was such "as to greatly handicap us in being helpful in cases like the instant one", but "we have seen no disposition on the part of Congress to broaden our jurisdiction". Notwithstanding

the statutory limitation and the precedent cases, the Court has here failed to heed the statute and to follow its own precedents. Only the Congress has authority to broaden the Court's power of revision so as to permit what the Court has done in this case; and this the Congress has not seen fit to do.

This Court should require the Court of Customs and Patent Appeals to comply with the statute and confine its decision to the points set forth in the reasons of appeal.

B. The federal trademark registration statute provides that the owner of a trademark may register his mark unless, among other things, it so resembles another's trademark or trade name as to be likely, when applied to the goods, to cause confusion, mistake or deception of purchasers. In the present case, as between these two parties, the District Court has found that respondent's use of "Dunhill", whether alone or with other language, is not only likely to cause confusion, mistake or deception of purchasers, but that it *has in fact* caused confusion and deception of the public. The Court of Customs and Patent Appeals has nevertheless authorized registration—concurrent registration for which no application has been filed.

The first clause of the proviso which permits concurrent registration of the same mark or a similar mark, however, states that such a registration may be granted only if the Commissioner or a court on appeal finds that there is no likelihood of confusion, mistake or deception of purchasers. Under the second clause of the proviso, which provides that concurrent registration may be *similarly* granted by the Commissioner, a finding that there is no likelihood of confusion, mistake or deception of purchasers is also required. However, there has been no such finding here. On the contrary, the District Court found the existence of actual confusion and deception, and the Court of Customs and Patent Appeals has made no finding at all in respect of this matter.

The Court of Customs and Patent Appeals has authorized registration of an instrument of deception—a name adopted and used with the purpose, intent and result of confusing the public—merely because the District Court found the existence of certain equitable rights between petitioner and respondent and therefore permitted a limited use by respondent of the name "DUNHILL TAILORS". The Court of Customs and Patent Appeals has failed to distinguish between a permission granted by the District Court, due to the special circumstances existing between the parties, and a substantive right, which presumes respondent's ownership of the name and the right to exclude others from using it.

The Court of Customs and Patent Appeals has in previous cases held that, although under the principles of equity it sometimes happens that by virtue of the conduct of the parties more than one person may use a trademark, only one can own it for purposes of registration with the presumptions of ownership and exclusive rights which go with such registration. *Meem-Haskins Coal Corporation* v. *Central Fuel Corporation*, 137 F. 2d 242 (1943); *Proctor & Gamble Co.* v. *J. L. Prescott Co.*, 77 F. 2d 98 (1935); *Alumatone Corporation* v. *Vita-Var Corporation*, 183 F. 2d 612 (1950).

15 U.S.C. § 1051 provides that in the case of every application claiming concurrent use, the applicant shall state exceptions to his claim of exclusive use, in which he shall specify, to the extent of his knowledge, any concurrent use by others, the goods or services in connection with which and the areas in which each concurrent use exists, the periods of each use, and the goods and area for which the applicant desires concurrent registration. *This has not been done.*

The proviso of 15 U.S.C. § 1052(d) prescribes the procedure to be followed when such an application is filed. *This procedure has not been followed.*

The first clause of the proviso of 15 U.S.C. § 1052(d) provides for concurrent registration of the same or similar marks when more than one person has become entitled to use such marks as a result of their concurrent lawful use and the Commissioner or a court on appeal finds that confusion or deception of purchasers is not likely to result from the continued use of such marks. *Here, there has been no finding that respondent has become entitled to use "DUNHILL TAILORS" as a result of its concurrent lawful use; neither has there been any finding by the Commissioner or by any court that confusion or deception of purchasers is not likely to result from respondent's continued use of "DUNHILL TAILORS".* There has been only the finding by the District Court that respondent's use of "Dunhill", whether alone or with other language, has caused confusion and deception of the public, and it does not appear that such confusion and deception will cease in the future.

The second clause of the proviso of 15 U.S.C. § 1052(d) provides that concurrent registration may be *similarly* granted by the Commissioner when a court has finally determined that more than one person is entitled to use the same or similar marks; in other words, if it is found that there is no likelihood that confusion or deception of purchasers will result from the continued use of such marks. *There has been no such finding here.*

Furthermore, the first sentence of 15 U.S.C. § 1052(d) is an absolute prohibition against registration of a mark which is likely, when applied to the goods of the applicant, to cause confusion or deception of purchasers; and the concurrent registration proviso of that section does not supersede the prohibition of the first sentence except in so far as the prohibition becomes inapplicable in the event that it is found that confusion or deception is not likely to result from the continued use of such mark.

The District Court has merely found that, as between the two parties, petitioner and respondent, respondent has

certain equitable rights. So far as the public is concerned, however, respondent has no substantive rights, and, therefore, the right to register, with the presumptions of ownership and exclusive right to use, cannot exist because in respondent's hands "Dunhill", whether alone or with other language, has been, is, and can only be an instrument for deceiving the public. By the first sentence of 15 U.S.C. § 1052(d), Congress has prohibited registration under such circumstances, and the concurrent registration proviso of this section does not supersede or in any way circumscribe that prohibition. The Court of Customs and Patent Appeals has been prohibited by Congress from authorizing registration of "DUNHILL TAILORS" under the circumstances of this case.

Conclusion

The Court of Customs and Patent Appeals has clearly exceeded its authority and disregarded the statutory limitations applicable to its jurisdiction. The circumstances of this case require that this Court exercise its power of supervision.

Dated: New York, New York, March 15, 1962.

Respectfully submitted,

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APPENDIX A

ALFRED DUNHILL OF LONDON, INC., Appellant,

v.

DUNHILL TAILORED CLOTHES, INC., Appellee.

Patent Appeal No. 6697.

United States Court of Customs and Patent Appeals.

Aug. 16, 1961.

RICH, Judge.

Alfred Dunhill of London, Inc., opposer, here appeals from the decision of the Trademark Trial and Appeal Board, 124 USPQ 343, dismissing its opposition to registration of DUNHILL TAILORS on the Principal Register as a trademark for men's suits and overcoats.

This opposition is unusual in that behind it lies an infringement suit brought by opposer against applicant, in which applicant counterclaimed for affirmative relief of various kinds. This suit, in the United States District Court for the Southern District of New York, is Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc., 119 USPQ 325. It was decided September 22, 1958, by the entry of a final judgment from which no appeal was taken. It is hereinafter referred to as the "suit."

On the basis of the decision in that suit, the applicant filed a motion to dismiss the notice of opposition on the ground that it failed to state a claim on which relief could be granted or, in the alternative, for summary judgment in favor of applicant. Opposer thereafter filed a cross-motion for summary judgment sustaining the opposition and requested an oral hearing.

Appendix A

The board denied oral hearing, denied opposer's motion for summary judgment, granted "Applicant's motion" and dismissed the opposition. Opposer speculates that it was applicant's motion for summary judgment, rather than to dismiss the opposition, that was granted but since the board did, *in haec verba*, dismiss the opposition, the distinction is of no importance. The parties agree that there is no genuine issue as to any material fact.

This case involves the single question of law whether, under the Lanham Act (Trademark Act of 1946, 15 U.S.C. § 1051 et seq., 15 U.S.C.A. § 1051 et seq.), applicant is entitled to registration on the basis of the rights of the parties hereto as settled in the suit.

Applicant, Dunhill Tailored Clothes, Inc., filed its application to register, Ser. No. 25,527, on March 5, 1957, claiming use since September 3, 1923. The application as filed asserted reliance on section 2(f) and alleged "substantially exclusive and continuous use in interstate commerce for the five years next preceding the date of filing of this application." The mark sought to be registered in the application as filed was DUNHILL and the specimen was a woven clothing label bearing DUNHILL beneath the "hill" portion of which in relatively smaller letters was the word "Tailors" and under it "New York."

On April 18, 1957, opposer brought the suit referred to above against the applicant and on August 16, 1957, the examiner deferred action on the application pending outcome of the suit,[1] in which final judgment was rendered September 22, 1958. November 18, 1958, the examiner

[1] It appears to be the usual practice to stay registration proceedings pending the outcome of court actions between the same parties involving related issues. A. E. Staley Mfg. Co. v. Staley Milling Co., 99 USPQ 175 (Com'r.), Townley Clothes, Inc. v. Goldring, Inc., 100 USPQ 57 (Com'r.), Squirrel Brand Co. v. Bernard Nut Co., Inc., 101 USPQ 340 (Com'r.), "Developments in the Law—Trade-Marks and Unfair Competition," 68 Harv. L. Rev. 814, 843.

refused registration because in the suit the applicant had been enjoined. Applicant responded on January 23, 1959, amending the drawing "by adding the word 'TAILORS' after the name DUNHILL," pointing out that the injunction provided that it might use the mark DUNHILL TAILORS on certain named products for men including "clothing," and submitting new specimens of that mark. The application was passed for publication June 29, published July 21 (744 O.G. TM 109), and this opposition was filed August 18, 1959. Then followed the motions and the decision of the board dismissing the opposition on February 17, 1960.

No facts have been developed in the opposition except as they appear from the pleadings, applicant's motion in effect admitting the allegations of the notice of opposition. But in addition thereto we have before us the published opinion of the District Court for the Southern District of New York (following an unpublished oral opinion on June 11, 1958) which consists of Findings of Fact and Conclusions of Law (119 USPQ 325). Both parties argue this case on the basis of acceptance of those findings and conclusions and the final judgment in the suit, which judgment is the fact of paramount importance on the issue before us.

Reference is made to the reported findings of fact in the suit for a more complete statement, the important facts relevant here being summarized below.

Opposer, Alfred Dunhill of London, Inc., is a Delaware corporation with offices in New York City. It was incorporated under its present name June 1, 1921 and began business as exclusive distributor in the United States of "DUNHILL" products procured from Alfred Dunhill of London, England, who was succeeded in business by Alfred Dunhill Ltd., a corporation of Great Britain. Since May 15, 1922 opposer has operated a ground floor retail store in New York, in which "DUNHILL" products are sold, its present store being on Fifth Avenue at 50th Street. The

goods sold under the "DUNHILL" trademark or trade name in 1922 and since included tobacco products, smoker's articles, miscellaneous men's jewelry, flat leather goods, canes, umbrellas, golf balls, razors, clocks, desk sets, playing cards, bridge sets, mahjong sets, silver tea sets, tea caddies, bar fixtures and accessories, luggage, brief cases, travel cases, toilet cases, and other gift items.

Opposer either owns or is a licensee under many trademark registrations of or including the name DUNHILL granted to it or to Alfred Dunhill Ltd., seventeen being listed in the notice, for tobacco products, lighters, razors, clocks and watches, pipes, cigar and cigarette holders, cosmetics, soaps and shaving creams, tobacco pouches, billfolds, purses, handbags, document cases, and wallets. One registration, No. 634,071, Sept. 4, 1956, claiming first use in 1929, is for "ALFRED dunhill" as a trademark for men's ties. It is the only registration of opposer or its licensor in the clothing field.[2]

"DUNHILL" had a special significance, meaning opposer and its products, before applicant made any use of the mark and prior to the incorporation of applicant and has such significance at the present time.

Applicant was incorporated under its present name, under the laws of New York, on August 13, 1923, by one William Block and no one by the name of Dunhill has ever had any connection with applicant or the Block family. From 1923 to 1955 applicant occupied upper floor places of business at 230 Fifth Avenue, 39 West 32nd Street, and

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[2] This registration, along with the other 16, is listed in the final judgment in the suit but before signing it Judge Dimock, the trial judge, struck it out of the list of which the judgment said: "The following United States trademark registrations are good, valid and outstanding:" He thus refused to hold it to be a valid registration but neither did he hold it invalid. For our purposes we presume it to be valid. The registrations are all identified in the board's opinion, 124 USPQ 343, and in the suit, 119 USPQ 325.

1 West 52nd Street in New York. Since then and at present it occupies a ground floor store at 65 East 57th Street.[3]

From 1923 to November, 1955 applicant was primarily in the clothing business but incidentally sold many items of haberdashery, men's jewelry and the like, closely similar in kind to the sort of goods opposer was selling. In November, 1955 it moved to the 57th Street store and there used, as it had earlier, the name "DUNHILL" in referring to its various products and also used it in the term "DUNHILL TAILORS", where in the word "Tailors" was subordinated. Finding of Fact 29 in the suit reads:

> "29. Defendant used the word 'DUNHILL' in its business at 65 East 57th Street with the purpose, intent and result that a substantial number of members of the purchasing public were confused, mistaken or deceived into the belief that defendant and its products were plaintiff and its products or that defendant was a part or connected with plaintiff."

The district court concluded that applicant had infringed opposer's trademark and trade name rights, competed unfairly, and should be enjoined.

But there is another side to the story. The injunction which opposer obtained is, realistically, as much a decree protecting certain rights of applicant, which the court found to exist, as it is a victory for opposer. The equity,

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[3] We observe, dehors the record, that applicant, as "DUNHILL TAILORS," has a ⅓ page ad, showing this address, on page 60 of The New Yorker for June 3, 1961, and that opposer, as "ALFRED DUNHILL OF LONDON Fifth Avenue at 50th St., New York," and elsewhere, has two ⅙ page ads on pages 78 and 102 of the same issue. The former is for slacks and sports jackets and the latter for "Unique Gift[s]" consisting of desk clocks and Italian-made reproduction antique globes. This has not influenced our opinion. We set it forth merely as a matter of interest.

court found rights in both parties to the suit and undertook to protect them both.

Findings of Fact 30 through 38 in the suit relate to events which occurred during the years 1930-1956, a twenty-six year period, giving rise to an estoppel against opposer based on acquiescence. We shall not repeat them as they are succinctly summarized in Conclusion of Law 13, which was the basis of the judgment which both enjoins applicant and protects applicant in certain continuing rights to use "DUNHILL," the judgment being of record in the file of the application here on appeal. The court concluded:

> "13. In view of what has almost been cooperation between plaintiff [opposer] and defendant [applicant] in the latter's use of 'DUNHILL', plaintiff's long knowledge of defendant's use of its corporate and trade name, the close and friendly contact between representatives of plaintiff and defendant, and the facts that a Schulte [Arthur D. Schulte, whose family had an interest in applicant] who was a director of plaintiff was simultaneously a customer of defendant and that the Schultes were defendant's landlord at one time, that plaintiff's president was for seven years a clothing customer of defendant and also bought two ties from defendant and is presumed to have seen haberdashery on display at defendant's place of business, and that plaintiff's president sold 'DUNHILL' jewelry and offered 'DUNHILL' toiletries to defendant for resale, there was an implied assurance by plaintiff to defendant that defendant might continue the sale under the name it was then using, i. e., 'DUNHILL TAILORS', of the following products for men, as such products are defined and set forth in the findings of fact: clothing, jewelry, toiletries, haberdashery, flat leather goods, luggage and silent valets; provided,

> however, that whenever defendant so makes any use of 'DUNHILL TAILORS', the word 'Tailors' shall always be horizontally juxtaposed to 'Dunhill' and shall always be in the same form, font, style, size, color, and as prominent as 'Dunhill', and provided further that defendant shall not use 'DUNHILL TAILORS' in lower case."

The judgment of injunction conforms to the above conclusion 13. As to the last proviso, six of opposer's registrations depict the mark "DUNHILL" in a special type style which is all lower case with the tops of the letters "d", "h", and "l" greatly elongated. Applicant has been precluded from using that style, which appears to be opposer's current usage.

There is a further fact of minor importance which fits into the picture shown by the foregoing conclusion of law. It is thus recited in finding 20:

> "20. Defendant [applicant] applied to the United States Patent Office for the registration of 'DUNHILL' as a trademark for men's suits and overcoats on October 16, 1923 under the Trademark Act of 1920, and registration was issued under the said Act by the Patent Office on October 21, 1924, Registration No. 190,787, which registration expired on January 5, 1947."

We take notice that expiration was pursuant to section 46(b) of the Lanham Act, 15 U.S.C.A. § 1051 note and also that an application to register under the Act of March 19, 1920 was not subject to opposition, Fitzpatrick Brothers v. B. Heller & Co., 1925 C.D. 149, though subject to cancellation, Act of March 19, 1920, ch. 104, Sec. 2, 41 Stat. 534.

One final *fact* we note, sua sponte, is this: Notwithstanding the provision in section 37 of the Lanham Act giving the court in an action, such as the suit in New York, the power to "determine the right to registration" and notwithstanding the pendency of the application at bar during the suit, no determination was made in that suit of applicant's right to register DUNHILL TAILORS, or any other mark. Nothing brought to our attention would indicate that any effort was made to secure such a determination. The closest approach to utilization of section 37 was that defendant's [applicant's] counterclaim asked cancellation of opposer's Registration No. 634,671 for men's ties; but the court did not act on the request otherwise than to dismiss the entire counterclaim and to refuse to retain that registration in the list of those adjudicated valid.

Applicant correctly states that right to use, which was determined in the suit, and right to register, which was not, are "different 'causes of action'" and contends that nevertheless the holding of acquiescence in its rights to the mark in connection with men's clothing is res judicata in this proceeding. While issues actually litigated in another proceeding between the same parties would, as applicant contends, be res judicata in a subsequent proceeding between the same parties, it seems to us that the admission that applicant's right to a registration was a different "cause of action" and was not litigated disposes of that contention. We appreciate, of course, that the right to *use*, to the extent set forth in conclusion 13, is settled. We are left to decide the statutory right to *register*, however, on the basis of that established right to use. Taking that right into consideration, our problem is whether DUNHILL TAILORS can be registered to applicant under the Lanham Act in the face of opposer's opposition, opposer's rights to "DUNHILL" in various forms as evidenced by the registrations found valid by the court in the suit, its rights as

adjudicated in the suit to restrict applicant's use, the court's findings with respect to confusion, mistake, and deception of the purchasing public, *but taking into account also the applicant's rights as preserved in the judgment.*

The board, in dismissing the opposition, did so on the ground that the court's finding in the suit of applicant's right to use "precludes a finding of damage to opposer from the registration." It also found to be *implicit* in the decision of the district court *a holding*, with which it agreed, *that confusion*, in the sense of section 2(d) of the Lanham Act, *would be unlikely to result from applicant's use of* DUNHILL TAILORS *on men's suits and overcoats concurrently with opposer's use of* DUNHILL *for the goods enumerated in its registrations.* It is unclear which ground the board's decision rests on; but clearly it rests on the decision of the district court, whether it be no likelihood of confusion or no possibility of damage, which come to much the same thing.

However one may choose to describe the situation in legal terms, the cardinal fact is that applicant, by judicial decree, as against opposer, has the right to use DUNHILL TAILORS, the mark sought to be registered, as provided in the following paragraphs of the judgment in the suit:

> "That defendant may use the words 'DUNHILL TAILORS' on or in connection with the advertising, offering for sale and sale, including use in its corporate title, of the following products for men, as such products are defined in the Findings of Fact filed herein, namely clothing, jewelry, toiletries, haberdashery, flat leather goods, luggage and silent valets;
>
> "Provided, however, that when defendant so makes any use of 'DUNHILL TAILORS', the word 'Tailors' shall always be horizontally juxtaposed to 'Dunhill' and shall always be in the same form, font, style, size and

color and as prominent as 'Dunhill', and provided further that defendant shall not use 'DUNHILL TAILORS' in lower case type."

This right to continue to use DUNHILL TAILORS is the result of opposer's knowledge and long acquiescence which gave rise to an equitable estoppel. It is not, however, an unconditional right to use. It is indeed, explicitly restricted. In addition to the limitations of the above proviso, applicant is subject to a permanent injunction (provision "6" of the judgment), to which the paragraphs just quoted are an "exception," enjoining applicant

> "* * * from using 'DUNHILL' either alone or in any combination with other words or symbols in its corporate name, as a trademark, or on or in connection with the advertising, promotion, packaging, labelling, offering for sale or sale of any products whatsoever, or in any other manner whatsoever, with the following exception:".

What is not within the above quoted exception is within the prohibitions of this paragraph, framed to protect opposer's rights to "DUNHILL," as the exception is framed to protect applicant's rights.

Though it has not been so designated, it is apparent that what we have before us, at least with respect to right to use, is a court-approved concurrent use situation. Two corporations which have each been using "DUNHILL" for over a quarter century may, by judicial decree, both legally *use* "DUNHILL," applicant being subject to certain restrictions imposed for the protection of opposer, and opposer, correspondingly, restrained from interfering with applicant.

The Lanham Act, section 2(d), contemplates that where two parties have the legal right to use "the same or similar

marks" there may be corresponding concurrent registrations. But each of the several provisions of that section providing for concurrent registrations contains reference to

> "*conditions and limitations* as to *the mode* or place of use or the goods in connection with which such registrations may be granted *which conditions and limitations shall be prescribed in the grant* of the concurrent registrations * * *." (Emphasis ours.)

The "conditions and limitations" are such as would assure, *if* they were in fact restrictions on *use*,[4] that, in the words of section 2(d), "confusion or mistake or deceit of purchasers is not likely to result from the continued use of" the marks concurrently registered.

The second clause of the concurrent registration proviso in section 2(d) reads:

> "and concurrent registrations may be similarly granted by the Commissioner *with such limitations and conditions when a court has finally determined that more than one person is entitled to use the same or similar marks in commerce.*"

In the instant case the district court in New York made such a final determination. Knowing that opposer, the plaintiff in that suit, had the right to use "DUNHILL," it determined that applicant, the defendant there, also had a *limited* right to use it. But, apparently because applicant

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[4] It should be apparent that restrictions and conditions in a registration are not, under our common law principles of trademark law, restrictions and conditions on the *use* of the mark by the registrant. So far as the Lanham Act is concerned, the registrant is free to do as he pleases in *using* his mark. This follows logically from the fact that he does not derive his right to use from the registration. At most, conditions in a registration affect or limit only those rights derived from registration. Right to use is not one of them, nor right to use in any particular way, or place, or on any particular goods.

neither invoked the concurrent registration provision nor requested an order to register from the court (as it could have done under section 37), the board, by merely dismissing the opposition, opened the way to registration of DUNHILL TAILORS without any of the "conditions and limitations" in the grant which the statute contemplates in the case of concurrent registrations. It seems to us that such a registration would be contrary to the spirit, if not the letter, of the Lanham Act and would give a false picture of applicant's rights. Opposer would have good cause to complain of such a registration.

Applicant argues its right to register on the broad principle that right to register should be conformed to the right to use, citing authorities for the proposoition that this was one of the basic objectives of the Lanham Act, as indeed it appears to have been in the eyes of well-informed commentators. Robert, The New Trademark Manual, 55-56, 201 (1947); Robert, Commentary on the Lanham Trade-Mark Act, 15 U.S.C.A. following § 1024, at pages 271-272, 277-278 (1948),[5] the annual report of Derenberg on The Third Year of Administration of the Lanham Trademark Act of 1946, Patent Trademark and Copyright Weekly Reports, Vol. 86, No. 10, Part II, page 19, 40 T.M.Rep. 914, 940 (1950);[6] Vandenberg, Concurrent Registration of

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[5] This commentary, p. 278, speaking of the power given to courts to rectify the register, says: "This is a radical departure from prior law, but the provision will further the desire to have the registers reflect the *true status* of all marks *in use*." (Emphasis ours.)

[6] Derenberg, prefacing a discussion of application of equitable remedies under section 19 in inter partes proceedings, said: "* * * it was one of the avowed purposes of the Act of 1946 to eliminate as much as possible the former distinction between 'the right to use' and 'the right to register'." Compare "The Circular Trend in Trademarks" by Daphne Robert Leeds, author of the above Manual and Commentary, 47 A.B.A. Jour. 256, March 1961, p. 258, "* * * the statutory law [1946 Act] * * * had as one of its purposes the elimination of the distinction between the right to register and the right to use * * *."

Trademarks, 29 JPOS 720, 725 (1947), and authorities there cited. Applicant, however, does not appear to have made any effort to "conform" the registration it seeks with the right to use which it actually possesses, as defined in the district court judgment, by incorporating in the registration the limitation and conditions to which its right to use is subject. Under the circumstances of this case, we feel that this is a necessary prerequisite to the granting of the registration.

Opposer's arguments for reversal will now be considered. Its primary argument is that only an "owner" of a trademark is permitted by statute to register and that applicant is not an "owner." It is contended that the district court adjudged opposer to be the owner of "DUNHILL" and applicant to be an infringer when it used that mark in "DUNHILL TAILORS," wherefore applicant cannot be an owner of the latter mark. For the proposition that use of "DUNHILL TAILORS" was held to be an infringement, opposer cites Finding of Fact 28 which contains no such holding. Nor can we find such a holding elsewhere as to "DUNHILL TAILORS" with both words equally prominent. Moreover, it is inconceivable that the court could have entertained such a thought while adjudicating that applicant was free to use that mark. At most, the court found unfair competition and or infringement where, as stated in finding 26, "'Tailors' was less prominent than 'Dunhill' and where 'Tailors' was inconspicuous," but obviously not where the form of the mark corresponded to the terms of the judgment quoted above. This brings the question down to this: can applicant own "DUNHILL TAILORS" as a trademark for men's suits and overcoats while opposer owns "DUNHILL," alone and in various other combinations, for other goods? We see no reason why not.

Opposer seems to regard it as an impossibility that two parties can own and register the same trademark. Not

only is that a commonplace where there is a sufficient difference in goods, even as to identical marks, Rohm & Haas Company v. The C. P. Hall Company, 91 USPQ 69, 72 (Exr. in Ch.), but the concurrent registration provisions of section 2(d) contemplate it even in the case of the same or similar goods. In the instant case we have some difference in both goods and marks but nevertheless a close question requiring the inhibitions of the injunction to minimize confusion. The principles of ownership, however, are not changed by this fact.

As property rights subject to "ownership" trademarks are sui generis. Since ownership grows out of and depends upon the continuance of use and the parties here have long used their respective marks, their rights having been carefully determined by the district court, we think that within its legitmate field of use applicant is as much an "owner" as is opposer.

Opposer contends that the amendment of the application was an admission that DUNHILL TAILORS is in legal effect the same as "DUNHILL." The amendment merely conformed the form of the mark to the rights established by the judgment. The Patent Office made no objection to it. The district court clearly felt they were not the same. We see no merit in this argument.

Opposer attempts to show how it would be damaged by the granting of the registration in any event. The gist of the argument is that applicant would obtain the various advantages of registration which the Lanham Act affords, viz.: a finding and evidence of "ownership," the right to use the mark, to mark it wi[illegible] notice of registration, constructive notice and eventual incontestability. We see no reason why applicant should not enjoy these advantages with respect to the limited rights it already enjoys in the use of the mark under the judgment. Opposer has failed to show us how it would be any worse off as a result of registration than it is now under the terms of the judg-

ment, *provided the registration is restricted to conform to the judgment.* Such a registration will do no more than aid applicant in the enforcement of substantive rights it already has.

The next point of opposer is, in effect, that right to register does not necessarily follow right to use. Of course we agree. Salem Commodities, Inc. v. Miami Margarine Co., 244 F. 2d 729, 44 C.C.P.A. 932, LeWait, Inc. v. Magna Power Tool Corp., 289 F. 2d 656, 48 C.C.P.A. 909. Applicant admits the validity of this point but says in reply that section 19 of the Lanham Act provides that

> "In all inter partes proceedings equitable principles of laches, estoppel, and acquiescence, where applicable may be considered and applied."

Applicant argues that this section "clearly applies to this proceeding" and that the "very purpose of Section 19 was to conform the right to register to the right to use as determined by judicial decree," but at the same time says "We need not be concerned here with the question whether laches is available in an opposition proceeding; the judgment of the District Court is based upon acquiescence and estoppel." Applicant's position is not too clear.

We do not see where *we* have any occasion to apply equitable principles or section 19 in this case. The applicable equitable principles were all applied in the district court in New York where the facts to support their application were proved. Opposer was there held to be estopped to interfere with applicant's use within the terms of the judgment. In this opposition applicant is relying on a judicially established right, not on estoppel. If the facts underlying the estoppel had been proved in the opposition, instead of in the New York court, then we might have occasion to rely on section 19 and to apply equitable principles, but such is not the case.

We are clearly of the view on the record before us that the applicable statutory law, which neither party has invoked but which we should nevertheless apply, Coshocton Glove Co. v. Buckeye Glove Co., 90 F. 2d 660, 664, 24 CCPA 1338, 1343, is that provision of section 2(d) which provides for concurrent registration "when a court has finally determined that more than one person is entitled to use the same or similar marks in commerce." That is the situation here and it is the determination of the district court in the suit between these parties which is controlling, no question as to the registrability of DUXHILL TAILORS apart from opposer's possibly adverse rights having been raised. Equally applicable, however, are the provisions of section 2(d) with respect to incorporating in the registration certificate the "conditions and limitations as to the mode or place of use or the goods." These "shall be prescribed in the grant."

We believe the board erred in approving, in effect, the granting of an unrestricted registration by dismissing the opposition.* We also believe that opposer is not entitled

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* For a Commissioner's decision holding that the clause of section 2(d) we find to be applicable to this case is not limited by the provision of the first clause of the proviso respecting use of the mark "prior to any of the filing dates of the applications involved," see Ex parte Crown Beverage Corp., 102 USPQ 312, 45 T.M.R. (Part II) 69. We agree with that holding.

In formally declared concurrent user proceedings it is the board which decides "the respective rights of registration." Section 17 (15 U.S.C. § 1067, 15 U.S.C.A. § 1067, as amended Aug. 8, 1958). We do not see that it is of any practical significance that the present inter partes proceeding is called an "opposition" when the facts are such as to require a decision on an issue of concurrent registration.

We have before us, as did the Patent Office, both of the interested parties, the finally adjudicated facts on which they ask to have their rights determined, the Commissioner has already decided to grant a registration, which in our opinion would be "concurrent" whether so

(Footnote continued on following page)

to prevent the grant to applicant of a registration on the mark described and for the goods named in its amended application, *provided* the registration contains, as contemplated by section 2(d) in such cases, conditions and limitations corresponding to those contained in that portion of the judgment entered Sept. 22, 1958 in the United States District Court for the Southern District of New York, in Civil Action No. 119-295, constituting the injunction and designated "6," which is of record in the application file.

Since the opposition was dismissed by the board without any such requirement, its decision must be *reversed*.

Reversed.

WORLEY, Chief Judge (concurring).

I agree that the board should be reversed but for different reasons than those advanced by the majority.

First, I fail to see how the district court action can be given the controlling weight accorded it by the majority. The jurisdiction, the facts, and the issues there were wholly

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(Footnote continued from preceding page)

named or not, and that proposed registration has already been published in the Official Gazette of the Patent Office, all as contemplated in section 2(d).

Section 18 (15 U.S.C. § 1068, 15 U.S.C.A. § 1068) provides that in "such proceedings," which is a reference back to section 17 (15 U.S.C. § 1067, 15 U.S.C.A. § 1067) and includes oppositions, such as we have here, the Commissioner may

> "* * * register the mark or marks for the person or persons entitled thereto, as the rights of the parties hereunder may be established in the proceedings: *Provided*, That in the case of * * * any mark based on concurrent use, the Commissioner shall determine and fix the conditions and limitations provided for in subsection (d) of section 2 of this Act.

Any registration granted to applicant-appellant will clearly be based on concurrent use, and section 18 gives the Commissioner authority —indeed makes a requirement— to determine, fix, and (under 2(d)) prescribe in the grant, the conditions and limitations under which the applicant has, by court decree, the right to use.

different from those here. There the basic issue was the right to *use;* here it is the right to *register.* That there are substantial differences between the two in fact as well as in law is too well established to require citation of authorities.

Second, I agree with the majority that "DUXHILL" had, and has, a "special significance." Indeed, it is so significant that there is no doubt in my mind that the average purchaser would associate "DUXHILL" and "DUXHILL TAILORS" to a degree prohibited by the provisions of Section 2(d)[1] of the Lanham Act. Surely it cannot be said that such confusion would *not* be *likely.*

It is interesting to note that no application for concurrent registration has been filed, considered by the Patent Office, raised by the parties, or set forth in the reasons of appeal to this court.

MARTIN, Judge (concurring).

I agree that the decision of the board should be reversed but on a different basis than that of the majority. The district court in its findings of fact found *inter alia:*

"27. Defendant's purpose in using the word 'DUXHILL' in connection with its business at its store at 65

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[1] Sec. 2. Trademarks registrable on the principal register

"No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

* * * * * *

"(d) Consists of or comprises a mark which so resembles a mark registered in the Patent Office or a mark or trade name previously registered in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion or mistake or to deceive purchasers; * * *"

East 57th Street was with the intent and for the purpose of trading upon plaintiff's reputation and goodwill.

"28. A substantial number of members of the public were confused, mistaken or deceived by defendant's use in its business of the word 'DUXHILL,' *whether alone or with other language*, into the belief that defendant was plaintiff, or that defendant was a branch of or connected with plaintiff and that defendant's goods were plaintiff's goods.

"29. Defendant used the word 'DUXHILL' in its business at 65 East 57th Street with the purpose, intent and result that a substantial number of members of the purchasing public were confused, mistaken or deceived into the belief that defendant and its products were plaintiff and its products or that defendant was a part of or connected with plaintiff." (Emphasis mine.)

and in its conclusions of law *inter alia* stated:

"10. The pleadings of each of the parties in this civil action respectively claim that there is likelihood of confusion, mistake and deception of the public by the use of 'DUXHILL' by the other party; and since plaintiff has proven that members of the public have in fact been confused, mistaken and deceived by defendant's use of 'DUXHILL' into the belief that defendant and its products are plaintiff and its products and that defendant is connected with plaintiff, defendant is guilty of trademark and trade name infringement and unfair competition with plaintiff."

In view of these findings of fact and this conclusion of law *and my own conviction* that applicant's use of "Dux-

HILL TAILORS" on its goods is likely to result in purchaser confusion, there is a serious question whether applicant is entitled to registration under the Lanham Act. Section 2 of that Act provides:

> "No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—
>
> * * * * * *
>
> "(d) Consists of or comprises a mark which so resembles a mark registered in the Patent Office or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion * * * or to deceive purchasers: *Provided*, That the Commissioner may register as concurrent registrations the same or similar marks to more than one registrant when they have become entitled to use such marks as a result of their concurrent lawful use thereof in commerce prior to any of the filing dates of the applications involved and *the Commissioner or a court on appeal determines that confusion or mistake or deceit of purchasers is not likely to result from the continued use of said marks under conditions and limitations as to the mode or place of use or the goods in connection with which such registrations may be granted* which conditions and limitations shall be prescribed in the grant of the concurrent registrations thereof; and concurrent registrations may be similarly granted by the Commissioner with such conditions and limitations when a court has finally determined that more than one person is entitled to use the same or similar marks in commerce." * * * (Emphasis mine.)

Appendix A

Although the majority opinion states that the board found that the District Court implied that confusion, mistake or deception of purchasers was unlikely, I find no such implication in the District Court decision. In fact, the plain words of the quoted findings of fact go far beyond the question of "likelihood of confusion, mistake or deception of purchasers" in stating:

> "28. A substantial number of members of the public were confused, mistaken or deceived by defendant's use in its business of the word 'DUNHILL,' *whether alone or with other language*. * * *" (Emphasis mine).

There is no finding of fact or conclusion of law which states categorically that the use of "DUNHILL TAILORS" by applicant is *not* likely to cause purchaser confusion which seems to me would have been in order if the court so believed, in view of the findings of fact and conclusions of law which indicate the contrary to be true.

We have before us this question: Does the law authorize the concurrent registration of a trademark which is so similar to another and the goods so related that purchaser confusion is not only likely but, as a matter of fact does exist, on the basis of opposer's long knowledge of and acquiescence in applicant's use of the trademark? I do not think so.

Although this court cannot interfere with the use of this trademark by applicant, we do have the responsibility of determining its registrability under these circumstances. In making this decision it seems to me that we have a problem of deciding in this instance whether the public interest or certain equitable rights of applicant should prevail.

There is no question but that this court has concluded that the public interest is not only involved but must be protected in situations involving purchaser confusion. In

Dubonnet Wine Corp. v. Ben-Burk, Inc., 121 F. 2d 508, 511, 28 CCPA 1298, this court said:

> "Appellee contends that since the registered mark 'Dubonnet' is owned by the opposer but is used by another it cannot be considered as a mark 'owned and in use by another,' under the confusion-in-trade clause of section 5 of the Trade-mark Act of 1905 as amended, * * * so as to bar registration of the mark 'Bourbonet.' We must not lose sight of the fact that the dominant purpose of the said clause is to protect the purchasing public from confusion and mistake. Sun-Maid Raisin Growers of California v. American Grocer Co., 40 F. 2d 116, 17 C.C.P.A., Patents, 1034; California Packing Corp. v. Tillman & Bendel, Inc., 40 F. 2d 108, 17 C.C.P.A., Patents, 1048; Skelly Oil Co. v. Powerine Co., 86 F. 2d 752, 24 C.C.P.A., Patents, 790, 'It [Congress] never intended that a trade-mark should be registered if its use was likely to cause confusion or mistake in the mind of the public or if purchasers were likely to be deceived by its use.' Sun-Maid Raisin Growers of California v. American Grocer Co., supra. * * *"

See also Lucky Heart Laboratories, Inc. v. Neumann, 154 F. 2d 519, 521, 33 CCPA 1034, where it was stated:

> "This court has held repeatedly that the primary purpose of that portion of the trade-mark law with which we are here concerned is to protect the public. See In re Laskin Brothers, Inc., 146 F. 2d 308, 32 C.C.P.A., Patents, 820; Schering & Glatz, Inc. v. Sharp & Dohme, Inc., 146 F. 2d 1019, 32 C.C.P.A. 827. * * *"

Although these decisions relate to the provisions of the 1905 Act, I believe the same rationale is applicable in the

consideration of the Lanham Act. Although we cannot prohibit the use of a mark, we can prohibit registration and all the rights and privileges that go with it. Whatever protection this affords the public, it is our duty to give under these circumstances.

I also believe that when the public interest is involved it takes precedence over the equitable rights of an individual insofar as the registration of a trademark is concerned. See Skookum Packers' Association v. Pacific Northwest Canning Co., 45 F. 2d 912, 18 CCPA 792 and Abell v. Beatrice Creamery Co., 79 F. 2d 751, 23 CCPA 735.

Furthermore, it is not clear to me how equitable rights existing between two parties[1] can justify the issuance of a registration in contravention of the express language of the statute.

For these reasons, I am of the opinion that the decision of the board should be *reversed*. However, I do not believe that applicant is entitled to registration even under the conditions suggested by the majority.

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[1] Section 19 of the Lanham Act (15 U.S.C. § 1069, 15 U.S.C.A. § 1069).

APPENDIX B

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

Monday, December 18, 1961

At a session of said court continued and held at the city of Washington, pursuant to adjournment, on this 18th day of December, A. D. 1961.

Present the Honorable Eugene Worley, Chief Judge, and the Honorables Giles S. Rich, I. Jack Martin and Arthur M. Smith, Associate Judges, and the Honorable William H. Kirkpatrick, United States Senior Judge for the Eastern District of Pennsylvania.

The court was opened for business in due form.

PATENT APPEAL 6697

ALFRED DUNHILL OF LONDON, INC.,

Appellant,

v.

DUNHILL TAILORED CLOTHES, INC.,

Appellee.

Appellant having duly filed petition for rehearing and due consideration thereon having been had, it is—

ORDERED that said petition be, and the same is hereby, denied.

Appendix B

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

OCTOBER TERM 1960

PATENT APPEAL NO. 6697

OPPOSITION NO. 39,224

ALFRED DUNHILL OF LONDON, INC.,

Appellant,

v.

DUNHILL TAILORED CLOTHES, INC.,

Appellee.

WORLEY, Chief Judge, concurring.

I agree that the board should be reversed but for different reasons than those advanced by the majority.

First, I fail to see how the district court action can be given the controlling weight accorded it below or by the majority here. The jurisdiction, the facts, and the issues there were wholly different from those here. There the basic issue was the right to *use*; here it is the right to *register*. That there are substantial differences between the two in fact as well as in law is too well established to require citation of authorities.

Second, I agree with the majority that "Dunhill" had, and has, a "special significance." Indeed, it is so significant that there is no doubt in my mind that the average purchaser would associate "Dunhill" and "Dunhill Tailors" to a degree which I think the provisions of Section 2(d) were intended to prevent.

It is interesting to note that no application for concurrent registration has ever been filed or considered by the Patent Office. It is not mentioned in the reasons of appeal to this court. Yet the net effect of the majority view is to order the board to grant concurrent registration. I have grave doubts that this court has that power.

APPENDIX C

District Court, S. D. New York

ALFRED DUNHILL OF LONDON, INC. v.

DUNHILL TAILORED CLOTHES, INC.

No. 119-295 Decided Sept. 22, 1958

DIMOCK, District Judge.

FINDINGS OF FACT

1. Plaintiff, Alfred Dunhill of London, Inc., is a Delaware corporation, incorporated on June 1, 1921 under said name, and has an office and places of business in the city, county and state of New York.

2. Defendant, Dunhill Tailored Clothes, Inc., is a New York corporation, incorporated on August 13, 1923 under said name, and has its office and place of business in the city, county and state of New York.

3. The amount in controversy, exclusive of interest and costs, exceeds $3,000.00.

4. Prior to September 1921, Alfred Dunhill, of London, England, had used "Dunhill" as his trademark in the United States on various products.

5. By an agreement of August 11, 1921, with said Alfred Dunhill, plaintiff became the exclusive distributor of "Dunhill" products in the United States, and said relationship has continued from that time to the present and is so continuing, first with said Alfred Dunhill and later (1923) with his successor in business, Alfred Dunhill Ltd., a corporation of Great Britain.

6. Plaintiff's sale of "Dunhill" goods from September 1921 until May 15, 1922 was solely at wholesale, but on May 15, 1922, plaintiff opened a retail store, and since that time,

plaintiff has sold goods bearing the trademark "Dunhill" both at wholesale and at retail.

7. Plaintiff's retail store in the City of New York occupied the ground floor store at 512-14 Fifth Avenue (S. W. corner of 43rd Street) from May 15, 1922 to November 18, 1933, and, since November 20, 1933, plaintiff has occupied and does now occupy the ground floor store (and the next two upper floors) at 620 Fifth Avenue (S. W. corner of 50th Street).

8. In 1922, plaintiff sold in its retail establishment tobacco products, smokers' articles, men's jewelry, including cuff links, tie-bars, key chains, pocket knives and dress sets, flat leather goods, including wallets, billfolds, key cases and passport cases, canes and umbrellas, golf balls, razors, clocks, desk sets, playing cards and bridge sets, mahjong sets, silver tea sets, tea caddies, bar fixtures and accessories, luggage, including brief cases, travel cases and toilet cases, and other gift items of various descriptions under the trademark and trade name "Dunhill."

9. From the time of the opening of the retail store in New York on May 15, 1922, plaintiff has constantly added to its retail line of "Dunhill" products, and included among such products have been items of haberdashery and toiletries and additional items of leather goods.

10. "Dunhill" had a special significance as meaning plaintiff and its products before defendant made any use of the word "Dunhill," i.e., before August 1923.

11. Prior to the incorporation of defendant, "Dunhill" was a well-known trade name and trademark, which meant plaintiff and its products to the purchasing public.

12. From prior to the time of the defendant's incorporation up to the present, "Dunhill" has had and now has a special significance to the purchasing public as meaning plaintiff and its various products.

Appendix C

13. Plaintiff is the owner of the following registrations for trademarks issued by the United States Patent Office:

DUNHILL, 355,304, March 8, 1938; Dunhill Double-Claro, 356,504, April 26, 1938; DUNHILL, 403,585, September 28, 1943.

14. Plaintiff is the exclusive user in the United States of the following trademarks registered in the United States Patent Office by said Alfred Dunhill Ltd., a corporation of Great Britain:

Alfred Dunhill (script), 155,951, June 13, 1922; Design, 203,732, September 22, 1925; DUNHILL, 403,661, October 5, 1943; DUNHILL, 404,218, November 9, 1943; DUNHILL, 406,638, April 11, 1944; Alfred Dunhill (script), 419,717, March 5, 1946; Alfred Dunhill (script), 421,429, June 4, 1946; DUNHILL, 527,207, July 4, 1950; DUNHILL, 527,208, July 4, 1950; DUNHILL, 534,705, December 12, 1950; DUNHILL, 539,892, March 27, 1951; DUNHILL, 540,389, April 3, 1951; DUNHILL DOUBLE-CLARO, 541,949, May 8, 1951; ALFRED DUNHILL, 634,071, September 4, 1956.

15. No one with the name of "Dunhill" has ever been connected with defendant or with the family of William Block, who incorporated defendant.

16. Defendant's founder, William Block, had before defendant's incorporation operated businesses with the following names:

Will Block's Quality Shop (Mt. Carmel, Pa.)
William Block Silks (New York, N.Y.)
Lock-Green Mills, Inc. (New York, N.Y.)

17. Defendant's founder, William Block, chose "Dunhill" as the dominant feature of defendant's corporate name.

18. The present officers of defendant, and sons of said William Block, have operated clothing businesses with the following names:

Willhouse, Inc.
Norman Block, Inc.

19. From the latter part of 1923 to the latter part of 1927, defendant's place of business was located on an upper floor at 230 Fifth Avenue; it occupied an upper floor at 39 West 32nd Street from late 1927 to late 1932; it occupied an upper floor at 1 West 52nd Street from late 1932 to November 1955; and from November of 1955 to the present time, defendant has occupied the ground floor at 65 East 57th Street; and these places are all in the city, county and state of New York.

20. Defendant applied to the United States Patent Office for the registration of "Dunhill" as a trademark for men's suits and overcoats on October 16, 1923 under the Trademark Act of 1920, and registration was issued under said Act by the Patent Office on October 21, 1924, Registration No. 190,787, which registration expired on January 5, 1947.

21. From 1923 to November 1955, defendant was primarily in the clothing business and during part of said time sold certain items incidentally to the sale of clothing, i.e., haberdashery, such as shirts, underwear, ties, handkerchiefs, gloves, socks, garters, belts and suspenders, men's jewelry, including cuff links and tie bars, scarves, robes, beachwear, slippers, and other items worn on the person, umbrellas, wallets and billfolds, luggage, including toilet cases and brief cases, watches and clocks, jewel boxes, travelling irons and silent valets.

26. Prior to and after moving in November 1955 to 65 East 57th Street, defendant used "Dunhill" in referring

to its products, and also used "Dunhill" in the combination "Danhill Tailors" in referring to itself and its products where "Tailors" was less prominent than "Dunhill" and where "Tailors" was inconspicuous.

27. Defendant's purpose in using the word "Dunhill" in connection with its business at its store at 65 East 57th Street was with the intent and for the purpose of trading upon plaintiff's reputation and goodwill.

28. A substantial number of members of the public were confused, mistaken or deceived by defendant's use in its business of the word "Dunhill," whether alone or with other language, into the belief that defendant was plaintiff, or that defendant was a branch of or connected with plaintiff and that defendant's goods were plaintiff's goods.

29. Defendant used the word "Dunhill" in its business at 65 East 57th Street with the purpose, intent and result that a substantial number of members of the purchasing public were confused, mistaken or deceived into the belief that defendant and its products were plaintiff and its products or that defendant was a part of or connected with plaintiff.

30. During the 1930s the Schulte family had an interest in plaintiff and a member of said family, Arthur D. Schulte, was a director of plaintiff while he was a customer of defendant and had the opportunity of observing whatever goods were displayed for sale by defendant in addition to clothing.

31. From 1933 for several years, a Schulte corporation was defendant's landlord at 1 West 52nd Street.

32. In 1935, plaintiff knew that defendant was in the tailoring business and defendant knew and had previously

known that plaintiff sold at retail, a wide variety of items and accessories for men.

33. From 1950 to 1956, plaintiff's president was a customer of defendant and purchased twenty custom made suits from defendant which required numerous fittings at defendant's place of business and he also purchased two neckties from defendant during that time.

34. As plaintiff's president, he sold to defendant's officers for their personal use various "Dunhill" lighters, he sold to defendant fifteen pairs of "Dunhill" cuff links for resale by defendant, and he offered to defendant for resale "Dunhill" men's toiletries.

35. Plaintiff had actual knowledge of defendant's use of the word "Dunhill" since at least the year 1933, when Arthur D. Schulte became a customer of defendant and when a corporation controlled by David A. Schulte, then president of plaintiff, became defendant's landlord.

36. Plaintiff never notified defendant of plaintiff's alleged rights respecting the use of the word "Dunhill" and defendant's alleged violations thereof until shortly before or after Christmas 1956.

37. Since at least the year 1933, there has been close and friendly relations between defendant and representatives of plaintiff.

38. The acts and conduct of the representatives of plaintiff amounted to an implied assurance to defendant that it might continue the sale of such articles as men's clothing, men's jewelry, toiletries, flat leather goods, luggage and haberdashery, including a silent valet.

39. The evidence establishes some confusion. Defendant, by its attorney, has offered that in making use of the word "Dunhill" in connection with the sale and/or advertising of the foregoing products, that defendant add the word "Tailors" as prominently as the word "Dunhill" is displayed.

40. Plaintiff is a Delaware corporation.

41. Defendant is a New York corporation.

42. The amount in controversy, exclusive of interest and costs, exceeds $3,000.00.

CONCLUSIONS OF LAW

1. This is a civil action for trademark infringement and unfair competition brought under the Trademark Laws of the United States (Trademark Act of July 5, 1946, 15 U.S.C. Secs. 1051 et seq.), under 28 U.S.C. Sec. 1338, and by virtue of diversity of citizenship of the parties and the amount in controversy.

2. This Court has jurisdiction of the parties and the subject matter of the action.

3. "Dunhill" was a good and valid common law trademark for tobacco products, smokers' articles, men's jewelry, including cuff links, tie bars, key chains, pocket knives and dress sets, flat leather goods, including wallets, billfolds, key cases and passport cases, canes and umbrellas, golf balls, razors, clocks, desk sets, playing cards and bridge sets, mahjong sets, silver tea sets, tea caddies, bar fixtures and accessories, luggage, including brief cases, travel cases and toilet cases, and other items of various

descriptions prior to 1923 and meant to the purchasing public the goods sold by plaintiff.

4. "Dunhill" was a good and valid common law trade name prior to 1923 and meant plaintiff to the purchasing public.

5. "Dunhill" has continued to be, from 1923 to date, and now is a good and valid common law trademark in the United States for such products then sold by plaintiff and for additional items, toiletries, haberdashery and leather goods as have from time to time been added to the lines of goods sold by plaintiff.

6. "Dunhill" has continued to be, from 1923 to date, and now is a good and valid common law trade name of plaintiff.

7. The following United States trade-mark registrations are all good, valid and outstanding:

Alfred Dunhill (script), 155,951, June 13, 1922; Design, 203,732, September 22, 1925; DUNHILL, 355,304, March 8, 1938; Dunhill Double-Claro, 356,504, April 26, 1938; DUNHILL, 403, 585, September 28, 1943; DUNHILL, 403,661, October 5, 1943; DUNHILL, 404,218, November 9, 1943; DUNHILL, 406,638, April 11, 1944; Alfred Dunhill (script), 419,717, March 5, 1946; Alfred Dunhill (script), 421,429, June 4, 1946; DUNHILL, 527,207, July 4, 1950; DUNHILL, 527,208, July 4, 1950; DUNHILL, 534,705, December 12, 1950; DUNHILL, 539,892, March 27, 1951; DUNHILL, 540,389, April 3, 1951; DUNHILL DOUBLE-CLARO, 541,949, May 8, 1951.

8. By its use of "Dunhill" in the advertising and sale of its goods, defendant has infringed plaintiff's trademark and trade name "Dunhill".

9. By its use of "Dunhill" in the advertising and sale of its goods, defendant has competed unfairly with plaintiff.

10. The pleadings of each of the parties in this civil action respectively claim that there is likelihood of confusion, mistake and deception of the public by the use of "Dunhill" by the other party; and since plaintiff has proven that members of the public have in fact been confused, mistaken and deceived by defendant's use of "Dunhill" into the belief that defendant and its products are plaintiff and its products and that defendant is connected with plaintiff, defendant is guilty of trademark and trade name infringement and unfair competition with plaintiff.

11. Defendant's use of "Dunhill" in its business constituted intentional infringement of plaintiff's trademark and trade name "Dunhill" and intentional unfair competition with plaintiff.

[1] 12. Plaintiff is entitled to an injunction against defendant's use of "Dunhill" either alone or in combination with other words or symbols in its corporate name, as a trademark, or on or in connection with the advertising, promotion, packaging, labelling, offering for sale or sale of any products whatsoever, or in any other manner whatsoever, with the following exception:

13. In view of what has almost been cooperation between plaintiff and defendant in the latter's use of "Dunhill", plaintiff's long knowledge of defendant's use of its corporate and trade name, the close and friendly contact between representatives of plaintiff and defendant, and the facts that a Schulte who was a director of plaintiff was simultaneously a customer of defendant and that the Schultes were defendant's landlord at one time, that plaintiff's president was for seven years a clothing customer of

defendant and also bought two ties from defendant and is presumed to have seen haberdashery on display at defendant's place of business, and that plaintiff's president sold "Dunhill" jewelry and offered "Dunhill" toiletries to defendant for resale, there was an implied assurance by plaintiff to defendant that defendant might continue the sale under the name it was then using, i.e., "Dunhill Tailors", of the following products for men, as such products are defined and set forth in the findings of fact: clothing, jewelry, toiletries, haberdashery, flat leather goods, luggage and silent valets; provided, however, that whenever defendant so makes any use of "Dunhill Tailors", the word "Tailors" shall always be horizontally juxtaposed to "Dunhill" and shall always be in the same form, font, style, size, color, and as prominent as "Dunhill", and provided further that defendant shall not use "Danhill Tailors" in lower case.

14. The counterclaim is dismissed.

15. Plaintiff shall recover no profits or damages from defendant.

16. Each party shall pay its own costs.

APPENDIX D

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF NEW YORK

M'FILMED

Civil Action No. 119-295

ALFRED DUNHILL OF LONDON, INC.,

Plaintiff,

v.

DUNHILL TAILORED CLOTHES, INC.,

Defendant.

(U. S. District Court)
(Filed)
(Sep 22 1958)
(S. D. of N. Y.)

FINAL JUDGMENT

This civil action having been commenced on April 18, 1957, and having come on to be heard by the Court sitting without a jury, on June 3, 4, 5, 6, 9, 10 and 11, 1958, inclusive, on the complaint, amended answer and counterclaim, and trial having been had and testimony and proofs of both parties having been taken, and arguments having been presented and briefs filed, and plaintiff having been represented by Leslie D. Taggart and George P. Kramer, Esqs., of Watson Leavenworth Kelton & Taggart and defendant having been represented by Daniel A. Shirk, Daniel Waxman and Matthew T. Abruzzo, Jr., Esqs., and due deliberation having been had thereon, and an oral opinion having been rendered on June 11, 1958, it is hereby

Appendix D

ORDERED, ADJUDGED AND DECREED:

1. The Court has jurisdiction of this civil action for trademark infringement and unfair competition under the Trademark Laws of the United States and by virtue of diversity of citizenship and the amount in controversy.

2. Since prior to defendant's incorporation and commencement of business, "Dunhill" has been and now is plaintiff's trade name and its trademark for a wide variety of products.

3. The following United States trademark registrations are good, valid and outstanding:

Mark	*Registration*	*Issued*
Alfred Dunhill (script)	155,951	June 13, 1922
Design	203,732	September 22, 1925
DUNHILL	355,304	March 8, 1938
Dunhill Double-Claro	356,504	April 26, 1938
DUNHILL	403,585	September 28, 1943
DUNHILL	403,661	October 5, 1943
DUNHILL	404,218	November 9, 1943
DUNHILL	406,638	April 11, 1944
Alfred Dunhill (script)	419,747	March 5, 1946
Alfred Dunhill (script)	421,429	June 4, 1946
DUNHILL	527,207	July 4, 1950
DUNHILL	527,208	July 4, 1950
DUNHILL	534,705	December 12, 1950
DUNHILL	539,892	March 27, 1951
DUNHILL	540,389	April 3, 1951
DUNHILL DOUBLE-CLARO	541,949	May 8, 1951
[ALFRED DUNHILL FJD	634,071	September 4, 1956]

[Matter enclosed between brackets erased in copy.]

4. By its use of "Dunhill" in its business, defendant has infringed plaintiff's trade name and trademark "Dunhill" and has competed unfairly with plaintiff.

5. Defendant's use of "Dunhill" in its business was with the intent and for the purpose of causing confusion, mistake or deception of the public and the result of defendant's use of "Dunhill" has been that the public has been confused, mistaken and deceived.

6. Defendant and its officers, directors, servants, agents and employees and any and all persons acting by or under its authority or in privity with it are hereby permanently enjoined from using "Dunhill", either alone or in combination with other words or symbols in its corporate name, as a trademark, or on or in connection with the advertising, promotion, packaging, labelling, offering for sale or sale of any products whatsoever, or in any other manner whatsoever, with the following exception:

That defendant may use the words "Dunhill Tailors" on or in connection with the advertising, offering for sale and sale, including use in its corporate title, of the following products for men, as such products are defined in the Findings of Fact filed herein, namely, clothing, jewelry, toiletries, haberdashery, flat leather goods, luggage and silent valets:

Provided, however, that when defendant so makes any use of "Dunhill Tailors", the word "Tailors" shall always be horizontally juxtaposed to "Dunhill" and shall always be in the same form, font, style, size and color and as prominent as "Dunhill", and provided further that defendant shall not use "Dunhill Tailors" in lower case type.

7. Defendant's counterclaim is dismissed.

8. Plaintiff shall recover no profits or damages from defendant.

9. Each party shall pay its own costs.

10. That the defendant is hereby given permission to sell or dispose of whatever products it now has on hand even though they may not fall into any of the above classes of goods and the defendant is hereby given further permission to use up its present supplies of boxes, labels, wrappings, dress and advertising matter until said supplies shall have been exhausted.

Dated: September 22, 1958

E. J. Dimock
United States District Judge

Judgment entered
this 22 day of September, 1958.

Herbert A. Charlson
Clerk
J S

APPENDIX E

EOE
Paper No. 21

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE

Trademark Trial and Appeal Board

Alfred Dunhill of London, Inc.,
v.
Dunhill Tailored Clothes, Inc.
Serial No. 25,527

Opposition No. 39,224

Motions

WATSON, LEAVENWORTH, KELTON & TAGGART for Alfred Dunhill of London, Inc.

KAYE, SCHOLER, FIERMAN, HAYS & HANDLER for Dunhill Tailored Clothes, Inc.

Before BAILEY, LEACH and LEFKOWITZ, Members.

Opinion by LEEKOWITZ, Member:

An application has been filed by Dunhill Tailored Clothes, Inc., to register "DUNHILL TAILORS" for men's suits and overcoats, use since September 3, 1923 being asserted.

Appendix E

Registration has been opposed by Alfred Dunhill of London, Inc., which alleges ownership of numerous registrations for trademarks consisting of or comprising the term "DUNHILL" for such various goods as tobacco, cigars, cigarettes, cigar and cigarette lighters, razors, clocks and watches, cosmetic preparations, soap and shaving creams, tobacco pouches, billfolds, purses, handbags and men's ties.[1]

Each of the parties has moved for summary judgment, urging that it is entitled thereto in view of the final determination of a civil action involving the same parties and subject matter. (Alfred Dunhill of London Inc. v. Dunhill Tailored Clothes, Inc., 119 U.S.P.Q. 325, D. C. N. Y. 1958)

The court in the civil action enjoined applicant from making use of the term "DUNHILL" per se as a trademark for any product whatsoever; but permitted applicant to continue to use the notation "DUNHILL TAILORS" as a trademark for various goods, including the items of men's suits and overcoats covered by the application in question. That decision is conclusive, as between the par-

---

[1] Reg. No. 155,951, issued June 13, 1922 and renewed; Reg. No. 203,732, issued Sept. 22, 1925 and renewed; Reg. No. 355,304, issued Mar. 8, 1938 and renewed; Reg. No. 356,504, issued Apr. 26, 1938 and renewed; Reg. No. 403,585, issued Sept. 28, 1943, Reg. No. 403,661, issued Oct. 5, 1943; Reg. No. 404,218, issued Nov. 9, 1943; Reg. No. 406,638, issued Apr. 11, 1944; Reg. No. 419,717, issued Mar. 5, 1946; Reg. No. 421,429, issued June 4, 1946; Reg. No. 527,207 issued July 4, 1950; Reg. No. 527,208, issued July 4, 1950; Reg. No. 534,705, issued Dec. 12, 1950; Reg. No. 539,892, issued Mar. 27, 1951; Reg. No. 540,389, issued Apr. 3, 1951; Reg. No. 541,949, issued May 8, 1951 and Reg. No. 634,071, issued Sept. 4, 1956.

[2] Opposer has requested an oral hearing on the motions. It is the general practice, however, not to hold oral hearings on interlocutory motions; and an exception thereto appears unwarranted in the present instance. Opposer's request accordingly is denied.

ties, upon applicant's right to the use of the mark "DUNHILL TAILORS" for such goods, and precludes a finding of damage to opposer from the registration sought by applicant. See: Dwinell-Wright Company v. National Fruit Product Company, Inc., 67 U.S.P.Q. 120 (Comr., 1945), and Rum & Maple Tobacco Corporation v. Fleming-Hall Tobacco Co., Inc. (United States Tobacco Company, assignee substituted) 106 U.S.P.Q. 417 (Comr., 1955).

Opposer has argued that notwithstanding the court's decision, registration to applicant must be refused ex parte in view of Section 2(d) of the Statute. The decision in the civil action, however, by necessary implication means that in the court's opinion confusion would be unlikely to result from applicant's use of "DUNHILL TAILORS" for certain goods including men's suits and overcoats and opposer's use of "DUNHILL" for the goods identified in its registrations, and in this the Board concurs.

Decision:

Applicant's motion is granted; that of opposer is denied; and the opposition is dismissed.

S. LEFKOWITZ

A. D. BAILEY

M. LEACH

Members, Trademark Trial and Appeal Board

February 17, 1960

Office-Supreme Court, U.S.
FILED
APR 13 1962
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1961

No. 798.

ALFRED DUNHILL OF LONDON, INC.,

Petitioner,

v.

DUNHILL TAILORED CLOTHES, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF IN OPPOSITION.

MILTON HANDLER,
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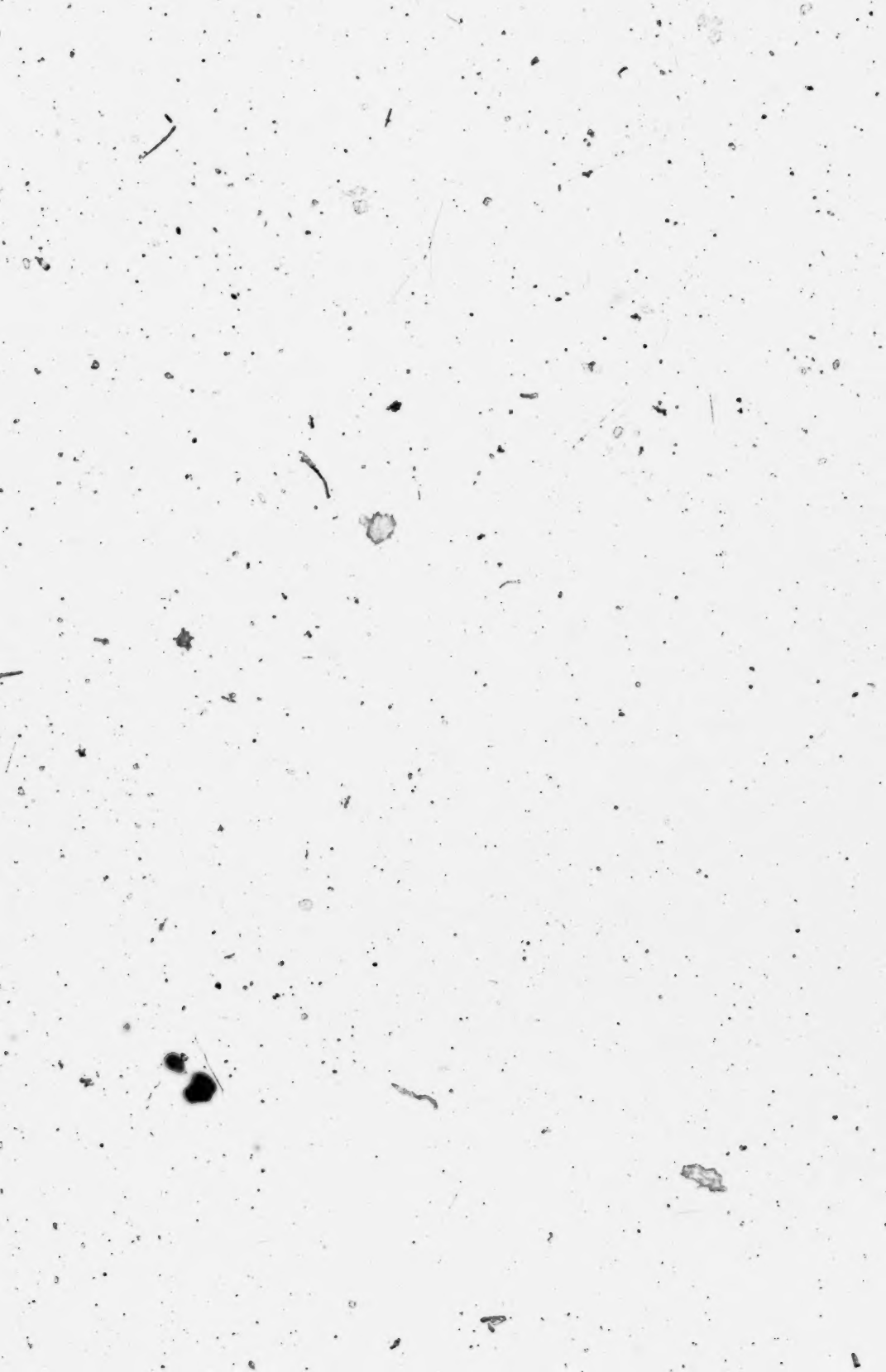

INDEX.

	PAGE
OPINIONS BELOW	1
JURISDICTION	1
QUESTIONS PRESENTED	2
STATUTES INVOLVED	3
STATEMENT OF THE CASE	3
ARGUMENT.	
I—This case arises on a unique set of facts and does not raise any issue of wide general importance	9
II—The Court of Customs and Patent Appeals plainly committed no error in the procedure it followed and the result it reached	11
CONCLUSION	14

Table of Cases

	PAGE
Coschocton Glove Co. v. *Buckeye Glove Co.*, 90 F. 2d 660 (C. C. P. A. 1937)	13
McBride v. *Teeple*, 311 U. S. 649 (1940)	2
Pacific Northwest Canning Co. v. *Skookum Packers' Ass'n*, 283 U. S. 858 (1931)	2
Postum Cereal Co. v. *California Fig Nut Co.*, 272 U. S. 693 (1927)	2
In re Tucker, 54 F. 2d 815 (C. C. P. A. 1932)	11

Statutes

Trademark Act of 1905,	
15 U. S. C. §§81-109	13
Trademark Act of 1920,	
15 U. S. C. §§121-128	5
Trademark Act of 1946,	
15 U. S. C. §1051	5
15 U. S. C. §1052(d)	3, 7, 10, 11, 13, 14
15 U. S. C. §1062a	6
15 U. S. C. §1063	6
15 U. S. C. §1069	14
15 U. S. C. §1071	3, 11
15 U. S. C. §1119	9
Judicial Code,	
28 U. S. C. §1256	1
Patent Code,	
35 U. S. C. §144	3, 11

Other Authorities

Derenberg, The Third Year of Administration of the Lanham Act of 1946, 40 Trademark Reporter 914, 940 (1950)	14
Robert, The New Trademark Manual 55-56, 201 (1947)	14
Note, The Lanham Act and the Right to Register, 39 Geo. L. Rev. 294 (1951)	14

IN THE

Supreme Court of the United States

OCTOBER TERM, 1961.

No. 798.

ALFRED DUNHILL OF LONDON, INC.,

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v.

DUNHILL TAILORED CLOTHES, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF IN OPPOSITION.

Opinions Below.

The opinion of the United States Court of Customs and Patent Appeals is reported at 293 F. 2d 685 and 130 U. S. P. Q. 412. It is also printed as Appendix A to the Petition. The opinion of the Trademark Trial and Appeal Board is reported at 124 U. S. P. Q. 343 and is printed as Appendix E to the Petition.

Jurisdiction.

Petitioner invokes this Court's jurisdiction under 28 U. S. C. §1256. However, this Court historically has taken the position that decisions by the Court of Customs and

Patent Appeals of the kind presented here are non judicial and therefore not subject to review on certiorari, *McBride* v. *Teeple*, 311 U. S. 649 (1940); *Pacific Northwest Canning Co.* v. *Skookum Packers' Ass'n*, 283 U. S. 858 (1931); *Postum Cereal Co.* v. *California Fig Nut Co.*, 272 U. S. 693 (1927); and there is no holding to the effect that the law in this regard has been changed.

The judgment of the Court of Customs and Patent Appeals was entered on August 16, 1961. A petition for rehearing was denied on December 18, 1961.

Questions Presented.

As framed by petitioner, the questions presented are set forth in such a biased and argumentative manner as to obscure the true issues in the case. Stated in a more restrained and accurate fashion, the same questions would appear as follows:

1. May the Court of Customs and Patent Appeals, on appeal from a decision of the Trademark Trial and Appeal Board in a trademark opposition proceeding, base its decision upon a clearly pertinent provision of the applicable federal statute, although the Trademark Trial and Appeal Board did not rely upon this particular provision and it was not invoked specifically on appeal to the Court of Customs and Patent Appeals?

2. May one whose right to use a trademark has been confirmed with certain limitations by prior judicial decree, on the basis of another's estoppel by acquiescence, be prevented by the estopped party from securing federal registration of such trademark, with the limitations of the judicial decree incorporated in the registration certificate?

Statutes Involved.

The petition sets forth the text of 35 U. S. C. §144 and 15 U. S. C. §1052(d). However, petitioner omits any mention of 15 U. S. C. §1071, the section of the Trademark Act of 1946 (Lanham Act) under which its appeal to the United States Court of Customs and Appeals was taken. This highly significant provision reads in pertinent part as follows:

> "Any • • • party to an opposition proceeding • • • who is dissatisfied with the decision of • • • the Trademark Trial and Appeal Board may appeal to the United States Court of Customs and Patent Appeals • • • as in the case of applicants for patents, under the same conditions, rules and procedure as are prescribed in the case of patent appeals or proceedings *so far as they are applicable* • • •" (emphasis added.)

Statement of the Case.

Petitioner seeks review of a decision of the United States Court of Customs and Patent Appeals under which respondent will be granted registration for the trademark "Dunhill Tailors" as applied to men's suits and overcoats, as a concurrent user with petitioner of the trademark "Dunhill," under conditions and limitations to be prescribed in the certificate of registration in the same terms as are set forth in a judgment of the United States District Court for the Southern District of New York entered in a prior civil litigation between the same parties. In the prior litigation, petitioner had sued respondent for trademark infringement growing out of respondent's use of "Dunhill" and "Dunhill Tailors," claiming that petitioner's various registrations for the trademarks "Dunhill" and "Alfred

Dunhill'' were infringed thereby. The basis of the decision in that case (from which no appeal was taken by either party) is explained sufficiently in the following quotation which constitutes paragraph 13 of the District Court's Conclusions of Law (printed in Appendix C to the Petition, at pp. 46-47):

> ''In view of what has almost been cooperation between plaintiff [petitioner] and defendant [respondent] in the latter's use of 'Dunhill', plaintiff's long knowledge of defendant's use of its corporate and trade name, the close and friendly contact between representatives of plaintiff and defendant, and the facts that a Schulte who was a director of plaintiff was simultaneously a customer of defendant and that the Schultes were defendant's landlord at one time, that plaintiff's president was for seven years a clothing customer of defendant and also bought two ties from defendant and is presumed to have seen haberdashery on display at defendant's place of business, and that plaintiff's president sold 'Dunhill' jewelry and offered 'Dunhill' toiletries to defendant for resale, *there was an implied assurance by plaintiff to defendant* that defendant might continue the sale under the name it was then using, i.e., 'Dunhill Tailors', of the following products for men, as such products are defined and set forth in the findings of fact: clothing, jewelry, toiletries, haberdashery, flat leather goods, luggage and silent valets; provided, however, that whenever defendant so makes any use of 'Dunhill Tailors', the word 'Tailors' shall always be horizontally juxtaposed to 'Dunhill' and shall always be in the same form, font, style, size, color, and as prominent as 'Dunhill', and provided further that defendant shall not use 'Dunhill Tailors' in lower case.'' (emphasis added.)

The explanation for the reference to ''lower case'' is that petitioner displays the mark ''dunhill,'' including the ini-

tial letter "d," in a distinctive style of lower case type (R. 57-65). This was noted in the opinion of the court below (Appendix A to Petition, at p. 19).

Two further significant facts are that respondent had registered "Dunhill" as its trademark for men's suits and overcoats in 1924 under the Trademark Act of 1920, 15 U. S. C. §§121-128, which registration expired in 1947 under the provisions of §46(b) of the Trademark Act of 1946, 15 U. S. C. §1051 note (see Finding No. 20 in District Court action, Appendix C to Petition, at p. 41); and that, of all petitioner's numerous trademark registrations for "Alfred Dunhill" and "Dunhill," there was only one in the clothing classification ("Alfred Dunhill" for men's ties, R. 69) and the District Court specifically refused to hold that particular registration valid, the reference to it in the final judgment of the United States District Court having been stricken out and initialed by the judge prior to his signature of the document submitted to him for that purpose (Appendix D to Petition, at p. 49).

The judgment was in the form of an injunction containing an exception permitting respondent to use "Dunhill Tailors" on the same goods and subject to the same limitations set forth in Conclusion of Law No. 13 (quoted above). As the Court of Customs and Patent Appeals expressed it, "The equity court found rights in both parties to the suit and undertook to protect them both." (Appendix A to Petition, at pp. 17-18.)

Prior to the institution of the infringement action in the District Court, respondent had filed an application for the registration of "Dunhill" as its trademark for men's suits and overcoats in the United States Patent Office, to replace the expired 1924 registration issued under prior law. Proceedings on this application were suspended by the Patent

Office pending the termination of the civil suit in the District Court, in accordance with normal practice. After the judgment of the District Court had become final, respondent amended its pending application to show the mark in the form of "Dunhill Tailors" which the District Court judgment permitted it to use, and the Patent Office approved the application.

When respondent's "Dunhill Tailors" mark was published in the Official Gazette pursuant to 15 U. S. C. §1062a, petitioner filed a notice of opposition. Both parties moved for summary judgment before the Trademark Trial and Appeal Board, taking the position that there was no dispute about any material fact and that only issues of law were involved.

Respondent's submission fundamentally was that the decision of the District Court was conclusive between the parties upon its right to use the mark "Dunhill Tailors" for certain goods, including those specified in the application for registration; and hence that petitioner lacked any legal standing to oppose since it must be presumed conclusively that it would suffer no "damage" from the registration of respondent's mark, the necessary prerequisite under 15 U. S. C. §1063. The Trademark Trial and Appeal Board agreed with this position and dismissed the opposition. (Appendix E to Petition.)

Petitioner then appealed to the United States Court of Customs and Patent Appeals. The majority of that court also believed that petitioner was not entitled to prevent the issuance to respondent of a registration covering the trademark "Dunhill Tailors" for men's suits and overcoats. However, the Court of Customs and Patent Appeals decided that the registration should contain conditions and limitations corresponding to those set forth in the applicable portion of the final judgment in the civil action be-

tween the parties. This paragraph of the judgment is essentially in the same terms as paragraph 13 of the Conclusions of Law quoted above. Specifically, paragraph 6 of the final judgment (Appendix D to Petition, at p. 50) enjoins the defendant from using "Dunhill" as a trademark with the following exception:

> "That defendant may use the words 'Dunhill Tailors' on or in connection with the advertising, offering for sale and sale, including use in its corporate title, of the following products for men, as such products are defined in the Findings of Fact filed herein, namely, clothing, jewelry, toiletries, haberdashery, flat leather goods, luggage and silent valets;
>
> "Provided, however, that when defendant so makes any use of 'Dunhill Tailors', the word 'Tailors' shall always be horizontally juxtaposed to 'Dunhill' and shall always be in the same form, font, style, size and color and as prominent as 'Dunhill', and provided further that defendant shall not use 'Dunhill Tailors' in lower case type."

The Court of Customs and Patent Appeals based its decision that the certificate of registration to be issued to respondent should repeat the limitations of the final judgment in the civil action on Section 2(d) of the Lanham Act, 15 U. S. C. §1052(d), which provides in part that concurrent registrations may be granted by the Commissioner of Patents "when a court has finally determined that more than one person is entitled to use the same or similar marks in commerce." This section also provides that concurrent registrations shall prescribe "conditions and limitations as to the mode or place of use or the goods in connection with which such registrations may be granted." Although respondent had not requested a concurrent registration

under this provision of the statute, the Court of Customs and Patent Appeals felt it proper under the circumstances to require that the certificate of registration enumerate the "conditions and limitations."

A fundamental proposition which petitioner's presentation of the case completely ignores is that two or more parties simultaneously can own and register the same or similar trademarks for different types of goods. This is a "commonplace" fact of commercial life, as the court below noted (Appendix D to Petition, at p. 26), and is perfectly lawful. The Court of Customs and Patent Appeals was fully conscious of the significance of this point; its opinion includes the following pertinent question and answer:

> "This brings the question down to this: can applicant own 'Dunhill Tailors' as a trademark for men's suits and overcoats while opposer owns 'Dunhill,' alone and in various other combinations, for other goods? We see no reason why not." (Appendix A to Petition, at p. 25.)

In summary, what happened to respondent's trademark application is this: the Patent Office Examiner decided that respondent was entitled to a registration of "Dunhill Tailors" for men's suits and overcoats without any restriction; the Trademark Trial and Appeal Board came to the same conclusion after petitioner had opposed the application for registration, and therefore dismissed petitioner's notice of opposition; the Court of Customs and Patent Appeals agreed that respondent was entitled to the registration, but prescribed a "concurrent" registration certificate restating the same conditions and limitations that had been set forth in the judgment of the District Court in the prior infringement action between the parties. Respondent has not taken issue with the decision of the Court of

Customs and Patent Appeals. Petitioner seeks to have this Court review it, arguing (1) That the Court of Customs and Patent Appeals had no authority to order a concurrent registration; and (2) That respondent is not entitled to any registration at all.

ARGUMENT.

I.

This case arises on a unique set of facts and does not raise any issue of wide general importance.

The special circumstances of this case are indicated amply by the quotation set forth above of paragraph 13 of the Conclusions of Law of the United States District Court of the Southern District of New York. An extremely unusual set of facts led the District Judge to decide that petitioner herein was estopped by its acquiescence from obtaining a complete injunction against all use of the term "Dunhill" by respondent; the District Court granted limited rights to respondent to use the term "Dunhill Tailors" in view of the unique circumstances of the case.

Neither party requested the District Court to issue any specific order to the Commissioner of Patents relating to the pending application of respondent for the registration of its trademark, although the District Court would have had the power to "determine the right to registration" under 15 U. S. C. §1119. Instead, respondent followed the alternative procedure of filing a copy of the judgment in the Patent Office in order to demonstrate that it had the right to use the mark on men's suits and overcoats in the form "Dunhill Tailors," and thus was entitled to registration.

Respondent's right to use the mark within the limitations and on the conditions set forth in the judgment of the District Court has been established and cannot now be overturned. Whether a party in such a position is entitled to a concurrent registration under 15 U. S. C. §1052(d) (as distinguished from an ordinary registration which does not set forth conditions and limitations), or whether the court below was wrong altogether in deciding that respondent was entitled to register its mark in the United States Patent Office, are not matters at all likely ever to arise again in this context nor do they have that degree of public importance which would justify review by this Court.

It should also be noted that petitioner is in the anomalous position of asking for a review of a judgment ostensibly in its favor. Petitioner was the appellant in the United States Court of Customs and Patent Appeals, seeking reversal of the decision of the Trademark Trial and Appeal Board. The Court of Customs and Patent Appeals did reverse the Trademark Trial and Appeal Board, which is precisely what petitioner had asked it to do. The judgment of the Court of Customs and Patent Appeals on August 16, 1961 (originally omitted from the petition but printed and added to it at a later date) simply ordered that "the decision of the Trademark Trial and Appeal Board be, and the same is hereby reversed." Accordingly, petitioner does not wish the decision of the Court of Customs and Patent Appeals to be reversed; its quarrel is with the grounds on which the judgment below was based, not the judgment of reversal itself.

II.

The Court of Customs and Patent Appeals plainly committed no error in the procedure it followed and the result it reached.

Petitioner's principal argument appears to be that the Court of Customs and Patent Appeals exceeded its statutory authority by ordering a concurrent registration in this case, because the issue of whether or not the registration should be a concurrent one under 15 U. S. C. §1052(d) was not specifically raised in the Patent Office or before the Court of Customs and Patent Appeals. Petitioner quotes 35 U. S. C. §144 as the governing statute on this point, emphasizing that portion of the section which states that the decision of the Court of Customs and Patent Appeals "shall be confined to the points set forth in the reasons of appeal." However, 35 U. S. C. §144 is part of the Patent Code; whereas as noted in the introductory portion of this brief, this appeal was brought under 15 U. S. C. §1071, which does not mention 35 U. S. C. §144: it provides merely that appeals to the Court of Customs and Patent Appeals in trademark cases shall follow the same procedures prescribed for patent appeals "so far as they are applicable."

What petitioner has overlooked is that the Court of Customs and Patent Appeals has long taken the position that there is a difference between patent and trademark cases, with specific reference to the scope of review. One of the cases on which petitioner relies in this very proceeding, *In re Tucker*, 54 F. 2d 815 (C. C. P. A. 1932), contains an explicit statement to that effect, as follows:

> "* * * we do not believe our powers and duties in trade-mark appeals are confined or restricted to the

same limits as they are in patent appeals." (at p. 816.)

The basis for the difference is not hard to apprehend. This Court can take judicial notice of the fact that appeals to the United States Court of Customs and Patent Appeals in patent cases involve typically a large number of extremely technical points and generally are concerned with whether certain specific portions of various claims in a patent application should have been allowed. All three of the cases cited by petitioner in support of this argument dealt with issues of that sort (Petition, p. 8). It is altogether proper for an appellant in such a case to be limited by the reasons of appeal set forth in his petition to the Court of Customs and Patent Appeals; the appellant is held to have waived any points which he fails to preserve in the petition of appeal, and the Court of Customs and Patent Appeals is directed by statute not to search the record for any such points. In trademark cases, on the other hand, the Court of Customs and Patent Appeals typically has before it issues of the proper construction or application of the Trademark Act. In the instant case, the Court of Customs and Patent Appeals specifically faced up to what it was doing; the court wrote:

> "We are clearly of the view on the record before us that the applicable statutory law, which neither party has invoked but which we should nevertheless apply [citation omitted], is that provision of section 2(d) which provides for concurrent registration 'when a court has finally determined that more than one person is entitled to use the same or similar marks in commerce.'" (Appendix A to Petition, at p. 28.)

In an earlier trademark case, *Coschocton Glove Co.* v. *Buckeye Glove Co.*, 90 F. 2d 669 (C. C. P. A. 1937), the Court of Customs and Patent Appeals had written (at p. 664):

> "A further suggestion has been offered that, to reach the conclusion which we have reached, it is necessary for us to pass upon questions not considered by the tribunals below and not raised in the reasons of appeal. So far as this may seem to be correct, it is sufficient to say that the questions which we decide are inherent in the case and hence should have been considered below • • •.
>
> "We have no doubt of this court's authority to take the course here taken, and regard it our duty to construe the statute and point out what we consider its proper application to the facts of the case."

In any event, the Reasons of Appeal in this case (R. 92-95) are stated with sufficient breadth to include the issue of concurrent registration under 15 U. S. C. §1052(d). Section 2(d) of the Lanham Act, which is 15 U. S. C. §1052(d), is invoked specifically no less than four times in the Reasons of Appeal and this is the same section under which the court below decided concurrent registration ought to be issued.

Petitioner's argument is that respondent is not the "owner" of the trademark "Dunhill Tailors" for men's suits and overcoats, and hence should not be permitted to register it. Support for this proposition is sought in three decisions of the Court of Customs and Patent Appeals (Petition, p. 10). Aside from their other deficiencies as authority here; these cases clearly are inapplicable because all of them were decided under the Trademark Act of 1905, 15 U. S. C. §§81-109, which is no longer in effect. One of the fundamental changes introduced into the law by the Trademark Act of 1946 (under which the instant case arises) was to make the right to register a mark conform to the right

to use the mark. Robert, The New Trademark Manual 55-56, 201 (1947); Note, The Lanham Act and the Right to Register, 39 Geo. L. Rev. 294 (1951); Derenberg, The Third Year of Administration of the Lanham Act of 1946, 40 Trademark Reporter 914, 940 (1950).

In order to carry out this purpose, the statute includes a provision making the equitable defenses of laches, acquiescence and estoppel applicable in oppositions and similar proceedings in the Patent Office (15 U. S. C. §1069). Petitioner's argument gives no effect to this provision and flouts the statutory purpose that registration should be co-extensive with the right to use.

So far as the merits are concerned, 15 U. S. C. §1052(d) provides for concurrent registration "when a court has finally determined that more than one person is entitled to use the same or similar marks in commerce." This provision fits the instant case like the proverbial glove.

Conclusion.

For the foregoing reasons, the petition for certiorari should be denied.

Respectfully submitted,

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